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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,825	05/09/2001	Stephen A. Canterbury	47079-00092	3932
30223	7590	06/28/2005	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			NGUYEN, KIM T	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,825

Applicant(s)

CANTERBURY, STEPHEN A.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9-12, 14-20 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-12, 14-20 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Examiner acknowledges receipt of the RCE filed with the amendment on 4/6/05. According to the amendment, claims 5-8, 13 and 21-22 have been canceled, claims 23-29 have been added, and claims 1-4, 9-12, 14-20, and 23-29 are pending in this application.

Claim Objections

1. Claim 28 is objected to because of the following informalities:

In claim 28, lines 1-2, the claimed limitation "gaming machine storage medium" should be corrected to "machine-readable medium".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. The newly added claim 25 contains new matter. The specification in page 7, lines 23-25 just disclose that the microcontroller loads a desired command into a command register. However, the specification does not disclose that microcontroller receives an address of the data register and disables the load condition of the data register. Further, the specification does not disclose using a microcontroller for preventing a writing operation as claimed in claim 29, line 3.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The dependency status of claim 27 is ambiguous. It is not clear if claim 27 is an independent claim or a dependent claim. If claim 27 is a dependent claim, claim 27 will be rejected under 112-4th paragraph for failing to further limit the method of claim 23. If claim 27 is an independent claim, the format for drafting claim 27 is inappropriate, and could be cause confusion in fee calculation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 9-12, 14-20, and 23-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Ozeki et al (US. Patent No. 5,402,385) in view of Helmbold et al (US. Patent No. 5,497,450) and Yokouchi (US Patent No. 5,802,332).

As per claim 1 and 4, Ozeki et al discloses a method for write protecting a storage medium including a data register capable of receiving external data after the load condition is enabled (Fig. 1A; col. 6, lines 24-29). The method comprises decoding a selected address of the storage medium, the address is selected by an external device (col. 5, lines 49-68; col. 6, lines 1-29; and col. 1, lines 16-19; col. 5, lines 49-52). Further, since Ozeki discloses preventing overwrite of game data (col. 3, lines 11-14 and col. 8, lines 22-23), Ozeki obviously encompasses teaching that the game data is not alterable through use of the program that controls write mode to the memory device. Ozeki et al does not disclose disabling the load condition as claimed. However, Helmbold et al discloses blocking the load signal (write signal) to prevent the protected

area of the data register being written to if the selected address matches an address of the data register (col. 8, lines 21-36) and Yokouchi discloses that deactivating a load control signal (ex. write control signal) will prevent the memory from being accessed (abstract, col. 19, lines 56-59). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to block the load signal as taught by Helmbold by disabling (deactivating) the load condition of the data register as taught by Yokouchi to the write protecting method of Ozeki in order to protect the protected data by disabling access to the memory device.

As per claim 2, Ozeki et al discloses including a write enable input (Fig. 1A; col. 4, lines 45-46; and col. 6, lines 41-53).

As per claim 3, including card enable inputs would have been well known to a person of ordinary skill in the art at the time the invention was made

As per claim 9-12, refer to discussion in claims 1-4 above.

As per claim 14-15, refer to discussion in claim 1 above. Further, implementing a processor and a removable memory in a gaming machine would have been old and known in the art.

As per claim 16-20, refer to discussion in claims 1-4 above. Further, as to claim 20, disabling two load conditions would have been both well-known and obvious design choice according to a designer's purpose.

As per claim 23-24 and 27-28, refer to discussion in claims 1, 15 and 23 above.

As per claim 25, Yokouchi discloses a microcontroller for controlling load conditions (col. 18, lines 31-34, 39-43, 48-53).

As per claim 26, a memory including a 50-pin connector, a single-chip controller, and flash memory modules would have been a well-known type of memory.

As per claim 29, refer to discussion in claims 1, 15, 23 and 25 above.

Response to Arguments

8. Applicant's arguments filed 4/6/05 have been fully considered but they are not persuasive.

In response to applicant's argument in page 7, last paragraph, through page 8, lines 1-3, and page 10, that there is no suggestion to combine references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for the rejection is found in the


knowledge generally available to one of ordinary skill in the art.

Applicant's argument in page 8, last paragraph, through page 9, last paragraph, is moot in view of the new ground of rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 703-872-9306.

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Date: June 21, 2005



Kim Nguyen
Primary Examiner
Art Unit 3713